

**REMARKS**

Claims 1-46 are pending.

In the *Office Action* mailed December 29, 2005, restriction was required to one of the following 13 groups:

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|------------|---|
| Group I    | Claims 1-4, 6-12, 14 and 16-26, drawn to metal chelates wherein L and L' are independently selected from those encompassed by the formula of claim 4, classified in class 534, subclass 10+.  |
| Group II   | Claims 1-3, 5, 7-13 and 16-26, drawn to metal chelates wherein L and L' are independently selected from formula B as set forth in claim 5, classified in class 534, subclass 10+.   |
| Group III  | Claims 1-3, 5, 7-13 and 16-26, drawn to metal chelates wherein L and L' are independently selected from formula C as set forth in claim 5, classified in class 534, subclass 10+.   |
| Group IV   | Claims 1-3, 5, 7-13 and 16-26, drawn to metal chelates wherein L and L' are independently selected from formula D as set forth in claim 6, classified in class 534, subclass 10+.   |
| Group V    | Claims 1-3, 5, 7-13 and 16-26, drawn to metal chelates wherein L and L' are independently selected from formula D' as set forth in claim 6, classified in class 534, subclass 10+.  |
| Group VI   | Claim 27, drawn to compositions comprising a metal chelate, excipient, buffer, and acidic and/or basic solution, and water as set forth in independent claim 27, classified in class 534, subclass 15.  |
| Group VII  | Claims 1-3, 5, 7-13 and 16-26, drawn to metal chelates wherein L and L' are not encompassed by Groups I-VI above, classified in class 534, subclass 10+.  |
| Group VIII | Claims 28-31 and 33-46, drawn to a method of diagnostic imaging wherein metal chelates wherein [sic] L and L' are independently selected from those encompassed by the formula of claim 31 are utilized, classified in class 534, subclass 10+. |
| Group IX   | Claims 28-30, 32 and 34-46, drawn to a method of diagnostic imaging wherein metal chelates wherein [sic] L and L' are independently select [sic] from formula B as set forth in claim 32 are utilized, classified in class 534, subclass 10+.   |

- Group X Claims 28-30, 32 and 34-46, drawn to a method of diagnostic imaging wherein metal chelates wherein [sic] L and L' are independently selected from formula C as set forth in claim 32 are utilized, classified in class 534, subclass 10+.
- Group XI Claims 28-30, 32 and 34-46, drawn to a method of diagnostic imaging wherein metal chelates wherein [sic] L and L' are independently selected from formula D as set forth in claim 33 are utilized, classified in class 534, subclass 10+.
- Group XII Claims 28-30, 32 and 34-46, drawn to a method of diagnostic imaging wherein metal chelates wherein [sic] L and L' are independently selected from formula D' as set forth in claim 33 are utilized, classified in class 534, subclass 10+.
- Group XIII Claims 28-30, 32 and 34-46, drawn to a method of diagnostic imaging wherein metal chelates wherein [sic] L and L' are not those encompassed by Groups VIII-XII above, classified in class 534, subclass 10+.

Applicants hereby elect, with traverse, Group I, namely claims 1-4, 6-12, 14 and 16-26, drawn to metal chelates, for prosecution on the merits.

Applicants further respectfully reserve the right to request a rejoinder of the appropriate non-elected claims which depend from any Group I claim if the Group I claims are ultimately found allowable, namely claims 28-31 and 33-46 of Group VIII.

Applicants further elect, with traverse, the species in which the metal chelate is gadolinium (III) 1,4,7-tris (carboxymethyl)-10-(2'-hydroxypropyl)-1,4,7,10-tetraazacyclododecane and the excipient is calcium bis[ 1,4,7-tris (carboxymethyl)-10-(2'-hydroxypropyl)-1,4,7,10-tetraazacyclododecanatocalcium(II)]. Claims 1-4, 7-12, and 15-20 are readable on the elected species.

Irrespective of the election made, Applicants respectfully traverse the Restriction Requirement, and respectfully request that it be favorably reconsidered and withdrawn.

**A. Groups I-XIII Should Be Combined**

As an initial matter, Applicants respectfully submit that all of the Groups set forth by the Examiner are directed to species of similar structure and property, and as such, should be combined into a single group.

Applicants further note that a search of the subject matter of each would not be a serious burden on the USPTO. Applicants also note that even if related inventions are shown to be distinct (which they are not), serious burden on the USPTO must be shown “by appropriate explanation.” MPEP § 808.02. Here, none has been provided.

As such, a comprehensive prior art search can be made under Applicants’ proposal without a significant burden on the USPTO, and thus, Applicants’ proposal is an appropriate modification of the Restriction Requirement.

As such, Applicants submit that all of pending claims 1-46 should be examined on the merits in the present application.

**B. The 13-Way Restriction Requirement is Improper**

The 13-way Restriction Requirement seems to have been made based merely on the assignment of the structures of each of formula A, B, C, D and D’ to a separate Group. However, as stated above, each of these formulas has similar structure and properties.

Moreover, as a result of the GATT legislation limiting the term of a patent to twenty years from its effective filing date, the delay in the examination of the non-elected claims will likely result in the patent term for those claims being unnecessarily shortened.

Under the present 13-way Restriction Requirement, the USPTO would have to conduct a duplicate, redundant search 13 times for each of those 13 divisional applications. If a

different Examiner is assigned to any of the divisional applications, an even more significant loss of USPTO resources and time would be incurred as a result of the examination of those divisional cases. Thus, Applicants respectfully submit that this proposal will result in a significant and unnecessary drain of USPTO resources. Accordingly Applicants respectfully submit that the 13-way Restriction Requirement is improper and should be withdrawn in favor of a Restriction Requirement that keeps all structurally similar species together.

If a telephone interview would be of assistance in the prosecution of this application, the Examiner is invited to telephone Applicants' undersigned attorneys at his convenience at the number provided below.

### CONCLUSION

No fees, other than the fee for the extension of time, are believed due in connection with the filing of this *Response to Restriction Requirement*. However, the Director is hereby authorized to charge any required fees and credit any overpayments to Deposit Account No. 50-0540.

Respectfully submitted,

February 28, 2006

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